

Application No. 09/911,108
Reply dated 24 August 2004
Responsive to Office Action mailed 29 June 2004

3 of 7

REMARKS**Amendments to the Description**

A paragraph has been amended to add the inadvertently omitted preposition "in".

A paragraph has been amended to supplement information identifying an application with information identifying the patent into which it matured.

Objection to the Specification

The Office Action contains an objection under 37 CFR 1.71 on the ground that the specification fails to adequately teach how to make and/or use the invention. It was alleged that, because no specific working example is given, undue experimentation would be required in order to identify materials, combinations of materials, or combinations of structure that would produce the desired end product.

This objection is hereby traversed and reference is made to MPEP 2164, in particular to its explanation that many factors must be considered in order to determine whether or not a disclosure is enabling and to its explicit explanation in 2164.02 that no specific working example is needed.

As is explained in MPEP 2164.03, "[t]he amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art." In the present case, the field of art is that of disposable absorbent articles. The level of knowledge, *i.e.*, of skill in this particular field of art, is relatively high. Similarly, the level of predictability in this field of art is relatively high. Therefore, the amount of guidance or direction needed to make and use a disclosed invention in this field is relatively low. In addition, the particular elements of the claimed invention that were mentioned in the objection are individually relatively highly predictable in nature. For example, it is well-known in the art that an absorbent capacity of a crotch region of an absorbent core relative to a total absorbent capacity of the absorbent core as a whole is fundamentally affected by the distribution of absorbent material.

In the subject Application, the inventors have provided many examples of suitable materials and have even incorporated by reference previous patents that describe in detailed working examples how to make the structural components of the claimed articles. Furthermore, rather than delineating a narrow ranges of values, each of the claims specifies either a minimum or a maximum for each of the various parameters that might be affected by the particular choices of materials. Given the high level of skill in the art and the high level of predictability when considering which materials to use, as well as the fact that any test value above a minimum or below a maximum falls within the claimed scope, it is

Application No. 09/911,108
Reply dated 24 August 2004
Responsive to Office Action mailed 29 June 2004

4 of 7

respectfully averred that undue experimentation is not, in fact, required. Each of the elements mentioned in the objection will now be addressed in support of this averment.

As mentioned above, the relative absorbent capacity of the crotch region of the absorbent core can be adjusted by distributing the absorbent material, e.g., by shaping the core so that the crotch region is smaller than the outlying regions, by varying the basis weight so that the crotch contains less mass per unit area than the outlying regions, by varying the concentration of absorbent gelling material so that the crotch contains a lower proportion than the outlying regions, *etc.* Alternative ways of achieving the same objectives are also known in the art. Furthermore, a method for determining the relative absorbent capacity is fully disclosed in the Test Methods section of the subject Application.

A detailed disclosure, including detailed working examples, of absorbent gelling materials having the desired values of saline flow conductivity, performance under pressure, and gel volume is found in U.S. Patent No. 5,599,335 to Goldman *et al.*, which is incorporated by reference in the subject Application. Please note that the claims reciting these parameters explicitly recite that it is the absorbent gelling material that has these properties, not the entire removable absorbent core, as misstated in the Office Action. In fact, these properties are explicitly attributed to the absorbent gelling material in the storage-redistribution member of the removable absorbent core component, making their recitation in the claims very specific. Furthermore, methods for determining the values of the three parameters are fully disclosed in the Goldman *et al.* '335 patent.

A detailed disclosure, including at least seven detailed working examples, of open-celled polymeric foam materials having the desired values of surface area per volume is found in U.S. Patent No. 5,387,207 to Dyer *et al.*, which is incorporated by reference in the subject Application.

With regard to the vertical wicking height, please note that the claim reciting this parameter explicitly recites that it is the acquisition/distribution member of the non-removable absorbent core component that has this property, not the entire non-removable absorbent core component, as misstated in the Office Action. It is clearly stated on page 19 of the specification as originally filed that the aforementioned fully disclosed polymeric foam materials and the aforementioned fully disclosed absorbent gelling materials are suitable and/or preferred for use as acquisition/distribution materials, sometimes in combination with well-known fibrous materials. Furthermore, the vertical wicking height measurement method is fully disclosed in U.S. Patent No. 5,147,345 to Young *et al.* and is incorporated by reference in the subject Application.

Application No. 09/911,108
Reply dated 24 August 2004
Responsive to Office Action mailed 29 June 2004

5 of 7

For discussion purposes, it is noted that according to MPEP 2164.06 I, in the case of *United States v. Teletronics, Inc.*, the court found that the question of studies costing \$50,000 (in 1988 dollars) and taking 6 to 12 months, standing alone, failed to show that undue experimentation would be required. It is averred that, in the present case, the amount of experimentation required to identify a suitable form for the absorbent core such that its crotch region has a certain proportion of its total absorbent capacity and to identify a suitable combination or combinations for a mere two materials, namely the absorbent gelling material and the open-celled polymeric foam material, would not take nearly as long as 6 to 12 months for one of ordinary skill in the art of disposable absorbent articles.

It is also worth mentioning that the references cited in the Office Action contain similar disclosures of varieties of materials that may be suitable for the various structural components of the disclosed articles. In fact, due to the nature of this field of art, it is typical to provide a "menu" of material options in patents whose claims are directed to overall structures and/or to functional ways of characterizing those structures, as well as in patents whose claims are directed to developments in one or a few of the materials, themselves. Thus, one of ordinary skill in the field of disposable absorbent articles would not find it unusual to be presented with the "menu" of material options in the subject Application, but would instead find it useful and helpful.

Accordingly, it is requested that the objection to the specification be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. § 112

Claims 1 through 18, i.e., all of the claims in the elected species, were rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Then, out of this group, Claims 1, 2, 5 through 8, and 13 were specifically listed in the next paragraph of the Office Action. It is noted that Claim 1 is the only independent claim in the subject Application.

These rejections are hereby traversed and reference is made to MPEP 2164, in particular to its explanation that many factors must be considered in order to determine whether or not a disclosure is enabling. Reference is also made to the preceding section of this Reply in which the objection to the specification was addressed.

With respect to Claims 1 and 2, please see the above discussion of the relative absorbent capacity of the crotch region of the absorbent core.

Application No. 09/911,108
Rcply dated 24 August 2004
Responsive to Office Action mailed 29 June 2004

6 of 7

With respect to **Claim 5**, please note that an expression of the concentration of a particular material by weight proportion is a very well-known and commonly accepted practice that, it is averred, needs no further explanation.

With respect to **Claims 6 through 8**, please see the above discussion of the absorbent gelling material.

With respect to **Claim 12**, please see the above discussion of the vertical wicking height and of the suitability of the fully disclosed absorbent gelling materials and the fully disclosed open-celled polymeric foam materials for use in the acquisition/distribution member of the absorbent core, where this parameter is of interest.

With respect to **Claim 13**, please see the above discussion of the open-celled polymeric foam materials.

In summary with regard to the claim rejections for lack of enablement, it is respectfully averred that one of skill in the field of disposable absorbent articles is, in fact, enabled by the disclosure of the subject Application to make and use the articles claimed in all of the pending claims. Accordingly, it is requested that the rejections of **Claims 1 through 18** under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 1 through 18, *i.e.*, all of the claims in the elected species, were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application Publication No. US 2004/0039361 A1 to LaVon *et al.* and **Claims 6 through 8** were separately rejected under 35 U.S.C. § 103(a) as being obvious over the same U.S. Patent Application Publication to LaVon *et al.* in light of U.S. Patent No. 5,599,335 to Goldman *et al.*

The subject Application and both of the cited references were, at the time the invention of the subject Application was made, owned by the common assignee of all three, namely The Procter & Gamble Company.

According to MPEP 706.02(1)(2)II, the above conspicuous statement alone is sufficient evidence to disqualify the cited LaVon *et al.* '361 patent application publication from being used in a rejection under 35 U.S.C. § 103(a). Nevertheless, the following assignment information is provided as objective evidence *in addition to* the statement.

Application No. 09/911,108 7 of 7
Reply dated 24 August 2004
Responsive to Office Action mailed 29 June 2004

<u>Document ID</u>	<u>Date Assignment Recorded</u>	<u>Reel</u>	<u>Frame</u>
This Application	10/29/2002	013207	0571
US 2004/0039361	9/9/2003	013961	0106
US 5,599,335	8/5/1994	07082	0952

Therefore, in accordance with MPEP 706.02(1)(2)II, the provision of 35 U.S.C. § 103(c) applies and the cited LaVon *et al.* '361 patent application publication is disqualified from being used in a rejection under 35 U.S.C. § 103(a). Accordingly, it is requested that the rejections of Claims 1 through 18 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Summary of this Reply

No new matter has been added in this reply. An objection to the specification and rejections of claim for lack of enablement have been addressed. A showing of common ownership has been provided to disqualify both cited references and thereby overcome claim rejections for obviousness.

Respectfully submitted,

By: Michael P. Hayden

Michael P. Hayden

Registration No. 48,433

Phone: (513) 626-5800

Fax: (513) 945-2958 or (513) 626-3004

24 August 2004

Customer No. 27752